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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/031,942 | 01/23/2002 | Yehouda Harpaz | | 8389 |

33953 7590 11/15/2005

YEHOUDA HARPAZ
129 CORRIE ROAD
CAMBRIDGE, CB1 3QQ
UNITED KINGDOM

| EXAMINER | |
|---|---|
| HOTALING, JOHN M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3714 | |

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10/031,942 | | | |

| EXAMINER | |
|---|---|
| ART UNIT | PAPER |
| | 20051102 |

DATE MAILED:

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**Commissioner for Patents**

Applicant has requested a status of the instant application. An appeal brief was filed 8/16/04 prosecution on the case was reopened on 11/12/04 with a non final office action. A final office action was mailed 10/5/05. The application is currently finaly rejected as of 10/5/05.

Attachment (1) is a copy of the final rejection.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/031,942 | HARPAZ, YEHOUDA | |
| | Examiner | Art Unit | |
| | John M. Hotaling II | 3713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *4 and 5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4 and 5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Terminal Disclaimer*

The terminal disclaimer filed on 12/27/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,568,683 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/031,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 4 of copending Application No. 10/031,890. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the use of an electronic game board for use in playing games with various sections illuminated in each of two colors.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 recites the limitations "the current player pattern and the opponent player pattern and the current player colour" in lines 10-12 of claim 5. There is insufficient antecedent basis for this limitation in the claim. These limitations need to be positively recited for the first time. For example a current player pattern and a opponent player pattern and a current player colour. Furthermore the use of quotes "" is not necessary in the claim. Additionally, after initially defining a positive recitation of a

claimed element, (e.g. a current player pattern) this recitation should be used throughout all of the claims See line 2 of claim 4 which states "the player's colour". The claims are replete with this type of error. Line 12 of claim 5 discloses "a player". Line 2 of claim 4 discloses "a player". After "a player has been positively recited the first time any subsequent listion of the term should be "said player", or "the player". Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner et al. (US Patent No. 5,573,245) further in view of Lites Out!

Weiner et al. disclose a grid of grid points on a flat surface where each grid point is a visible element (FIG 1-4) which is capable of detecting when it is pressed (Column

1, lines 22-30). Weiner et al. also disclose an illumination source inside and below the surface which is capable of illuminating the visible element (Figs. 13-14) by either of two colors (Column 6, lines 37-40). Weiner et al. disclose a game manager (FIG 9) connected electronically to the grid points (FIG 9, reference 20) as well as to the illumination source (FIG 9, reference 30). The microcontroller has control over the illumination and coloring of the squares (Column 4, lines 11-14). It also detects when a gird point is pressed (Column 4, lines 11-14). FIG 9 also shows a program and a memory associated with the CPU (microcontroller). The CPU manages the game and when a player presses a point, the illuminations of a pattern of points around this point are changed (Abstract). Weiner et al. discloses that the CPU uses a program to control the illuminations and patterns. Though Weiner et al. discloses two colors for use in the game, the disclosure does not explicitly state that when a player presses a point, the colors change to a player color if they were switched off or reverse colors if they were on. However, Lites Out! which is a mimic of the Weiner et al. patent with an improvement consisting of using two colors and an off state does make the changes as claimed. By using two colors and an off state, Lites Out! uses such a twist to make the game harder. Thus, the game would be more enjoyable to more experienced players who would less likely to tire of the game upon mastery. By adding a third color, thus a higher level of difficulty, one skilled in the art would recognize the added and lasting enjoyment that could be obtained. The function of the lights is disclosed as follows: In this mode, the object is the same, but each block can have 3 states; OFF, ON1 (yellow), or ON2 (blue). The direction the blocks change depends on the direction it was going

and the state of the main block that is being switched. Thus, colors are either switched on or reversed depending on the state they were in. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the program disclosed by Lites Out! into a structure such as the one disclosed by Weiner et al. As Lites Out! merely represents a program, it could easily be adapted or used by a skilled artisan to work in the structure of Weiner et al. wherein its addition would add lasting enjoyment to the device. As Weiner et al. already support multiple color lights as well as an off state, one would be motivated to do this, as discussed above, to provide a more challenging and testing device to continue to face and amuse experienced players; thereby, not alienating them when they learn and grow tired of the simplified Weiner et al device. Weiner et al. also states that the objective is to go from a starting configuration of indicator states to a desired configuration of indicator states (Column 2, lines 22-24). Weiner et al. follows with the example of an ending configuration where all the indicators are of the same state, i.e. lit (Column 2, lines 25-30). Weiner et al. is very open about what the goals can be and designates other possible ending configurations, thus indicating other such ending points would be of a design choice. In the above named case, the player would have the majority of the lights on, as that would be the ending phase.

Regarding claim 4, Weiner et al. states that the determination of which indicators change state upon the selection of one of the indicators is made based on the preset pattern or algorithm (Column 3, lines 5-7) and also states that the device can change the state of at least one of the non-selected indicators, perhaps also changing state of a

selected indicator (Column 3, lines 1-3) thus suggesting that the board performs changes only when an non-illuminated point is pressed as Weiner et al. indicates it is not required that the state of a selected indicator must be changed, it is only requires that at least a non-selected indicator be changed. One of ordinary skill in the art would be able to readily understand that any preset pattern may be used. Additionally, it is also desirable to give the user the ability to create and use one or more patters of his own design. With respect to claim 4 the disclosed patterns would be obvious to one of ordinary skill in the art since Weiner discloses that any pattern can be used.

***Response to Argument***

Applicant's arguments with respect to claims 4 and 5 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the applicants arguments relative to the provisional double patenting rejections based on applications 10/031,776 and 10/031,890 the examiner has considered all of the applicant's arguments but maintains the rejection for 2 reasons. First, it is the examiners position that the claimed subject matter for both of the applications uses the same game board and only changes the pattern. Secondly, the claims in the copending patent applications have not been allowed and it is not clear what claims limitations will be if those applications are in fact allowed.

"(c.2) The element that is found in Weiner et al is changing a pattern around the pressed point. However, the following elements are not found either in Weiner et al or in Lites Out!:"

(a) Using different patterns for the two colours." This feature is not claimed but is disclosed see below.

"(b) Switching the patterns between the colours in each turn (point press). Because the current colour changes each turn, the pattern that is applied to a colour is the one for the current colour in one point press and the other pattern in the next point press." Column 2 lines 49-59 discloses at least two colors, Column 3 lines 1-15 discloses a display activating means based on a preset pattern or algorithm as shown in figure 1-4

(c) The changes are only switching off of points. Column 2 lines 49-59 disclose the states used by the player and that more than two states may be used. Additionally, the rejection is based on the combination of reference and not what is only disclosed in Weiner. As can be seen in the rejection above using motivation provided by Weiner that a plurality of states can be used. Switching off of a point changes its color.

(d) The game ends when there are illuminated points only of one colour (and because points are only switched off, most of points are switched off). Note that the action mentioned that in Weiner et al they suggest ending with all points switched on, but that is a different condition. Switching off of a point changes its color.

(e) The colour of the illuminated points in the end is the winner.

With respect to (d) and (e) above, Weiner et al. also states that the objective is to go from a starting configuration of indicator states to a desired configuration of indicator states (Column 2, lines 22-24). Weiner et al. follows with the example of an ending configuration where all the indicators are of the same state, i.e. lit (Column 2, lines 25-30). Weiner et al. is very open about what the goals can be and designates other possible ending configurations, thus indicating other such ending points would be of a design choice. In the above named case, the player would have the majority of the lights on, as that would be the ending phase.

Applicant states that the elements make little or no sense at all since the references used are not set up for two player games. However two players are not claimed. Only a player and a current player are claimed. Weiner discloses in 5:44-55 that two players may play the game.

Applicant argues that the office action completely ignores a, b, c, and e above. In response to this claim please see the annotations next to the element where the claim limitations were not ignored.

***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed in PTO-892 are all related to game grids and games to be used with the game grids.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Hotaling II whose telephone number is (571) 272 4437. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272 3507. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING, II
PRIMARY EXAMINER

October 3, 2005

Attachment (1)

UNITED STATES PATENT AND TRADEMARK OFFICE

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